

REMARKS

The Office has required the restriction in the present application as follows:

Group I: Claims 4-7, 9, 21-30, and 35, drawn to a sintered body; and

Group II: Claims 13-15, 17-20, 31-34, and 36, drawn to a substrate.

Applicants note that Claim 22 is directed to a substrate, and therefore properly belongs in Group II. Accordingly, Applicants respectfully submit that Claims 4-7, 9, 21, 23-30, and 35 belong in Group I, and Claims 13-15, 17-20, 22, 31-34, and 36 belong in Group II.

Restriction is only proper if claims of the restricted groups are either independent or patentably distinct. The burden of proof is on the Office to provide reasons and/or examples to support any conclusion with regard to patentable distinctness. M.P.E.P. § 803.

Applicants respectfully traverse the requirement for restriction on the grounds that the Office has not provided adequate reasons and/or examples to support a conclusion of patentable distinctness between the identified groups.

The Examiner, citing PCT Rule 13.1 and 13.2, contends that Groups I and II do not relate to a single general inventive concept because they lack the same or corresponding to special technical feature. However, Applicants traverse the requirement for restriction on the grounds that the Office has not applied the same standard of unity of invention as the international preliminary examination authority. The authority did not take the position that unity of invention was lacking in the international application and examined all claims together (see the International Preliminary Examination Report appended herewith).

Applicants note that PCT Article 27(1) states that no national law shall require compliance with requirements relating to the form and content of the international application different from or additional to those which are provided for in the Patent Cooperation Treaty and the regulations.

Applicants point to Section V of the International Preliminary Examination Report, in which the international authority found that the present invention possessed novelty and inventive step.

Moreover, M.P.E.P. § 803 states:

If the search and examination of an entire application can be made without a serious burden, the Examiner must examine it on the merits, even though it claims to distinct or independent inventions.

Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the requirement for restriction.

Applicants therefore request that the requirement for restriction be withdrawn.

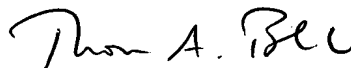
Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Customer Number

22850



Norman F. Oblon
Attorney of Record
Registration No. 24,618

Tel: (703) 413-3000
Fax: (703) 413-2220

Thomas A. Blinka, Ph.D.
Registration No. 44,541

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YASUTOMI & Associates

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PATENT COOPERATION TREATY

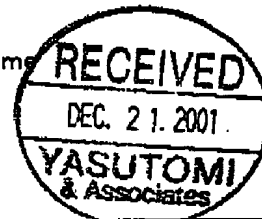
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NOTIFICATION OF TRANSMITTAL
OF COPIES OF TRANSLATION
OF THE INTERNATIONAL PRELIMINARY
EXAMINATION REPORT

(PCT Rule 72.2)

From the INTERNATIONAL BUREAU.

To:

YASUTOMI, Yasuo
Chuo Building
4-20, Nishinakajima 5-chome
Yodogawa-ku
Osaka-shi
Osaka 532-0011
JAPON

Date of mailing (day/month/year) 06 December 2001 (06.12.01)	
Applicant's or agent's file reference IB268WO	IMPORTANT NOTIFICATION
International application No. PCT/JP00/03041	International filing date (day/month/year) 12 May 2000 (12.05.00)
Applicant IBIDEN CO., LTD. et al	

1. Transmittal of the translation to the applicant.

The International Bureau transmits herewith a copy of the English translation made by the International Bureau of the international preliminary examination report established by the International Preliminary Examining Authority.

2. Transmittal of the copy of the translation to the elected Offices.

The International Bureau notifies the applicant that copies of that translation have been transmitted to the following elected Offices requiring such translation:

EP,CN,US

The following elected Offices, having waived the requirement for such a transmittal at this time, will receive copies of that translation from the International Bureau only upon their request:

KR

3. Reminder regarding translation into (one of) the official language(s) of the elected Office(s).

The applicant is reminded that, where a translation of the international application must be furnished to an elected Office, that translation must contain a translation of any annexes to the international preliminary examination report.

It is the applicant's responsibility to prepare and furnish such translation directly to each elected Office concerned (Rule 74.1). See Volume II of the PCT Applicant's Guide for further details.

The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland	Authorized officer Eliott PERETTI
Facsimile No. (41-22) 740.14.35	Telephone No. (41-22) 338.83.88

2003年 8月25日 23時26分

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Translation

PATENT COOPERATION TREATY

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference IB268WO	FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/JP00/03041	International filing date (day/month/year) 12 May 2000 (12.05.00)	Priority date (day/month/year) 06 September 1999 (06.09.99)
International Patent Classification (IPC) or national classification and IPC C04B 35/581		
Applicant IBIDEN CO., LTD.		

<p>1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of <u>4</u> sheets, including this cover sheet.</p> <p><input checked="" type="checkbox"/> This report is also accompanied by ANNEXES, i.e., sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).</p> <p>These annexes consist of a total of <u>4</u> sheets.</p>	
<p>3. This report contains indications relating to the following items:</p> <p>I <input checked="" type="checkbox"/> Basis of the report</p> <p>II <input type="checkbox"/> Priority</p> <p>III <input type="checkbox"/> Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</p> <p>IV <input type="checkbox"/> Lack of unity of invention</p> <p>V <input checked="" type="checkbox"/> Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement</p> <p>VI <input type="checkbox"/> Certain documents cited</p> <p>VII <input type="checkbox"/> Certain defects in the international application</p> <p>VIII <input type="checkbox"/> Certain observations on the international application</p>	

Date of submission of the demand 12 May 2000 (12.05.00)	Date of completion of this report 30 March 2001 (30.03.2001)
Name and mailing address of the IPEA/IP	Authorized officer
Facsimile No.	Telephone No.

2003年 8月25日 23時26分

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INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/JP00/03041

1. Basis of the report

1. With regard to the elements of the international application:*

- ☐ the international application as originally filed
- ☒ the description:
 pages 1-39, as originally filed
 pages _____, filed with the demand
 pages _____, filed with the letter of _____
- ☒ the claims:
 pages 4-7,13-15, as originally filed
 pages _____, as amended (together with any statement under Article 19
 pages _____, filed with the demand
 pages 9 (11.12.00) 17-26, filed with the letter of 24 January 2001 (24.01.2001)
- ☒ the drawings:
 pages 1-18, as originally filed
 pages _____, filed with the demand
 pages _____, filed with the letter of _____
- ☐ the sequence listing part of the description:
 pages _____, as originally filed
 pages _____, filed with the demand
 pages _____, filed with the letter of _____

2. With regard to the language, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

- These elements were available or furnished to this Authority in the following language _____ which is:
- ☐ the language of a translation furnished for the purposes of international search (under Rule 23.1(b)).
- ☐ the language of publication of the international application (under Rule 48.3(b)).
- ☐ the language of the translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any nucleotide and/or amino acid sequence disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.
- ☐ filed together with the international application in computer readable form.
- ☐ furnished subsequently to this Authority in written form.
- ☐ furnished subsequently to this Authority in computer readable form.
- ☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.
- ☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. ☒ The amendments have resulted in the cancellation of:

- ☐ the description, pages _____
- ☒ the claims, Nos. 1-3,8,10-12,16
- ☐ the drawings, sheets/fig _____

5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).**

* Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rule 70.16 and 70.17).

** Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.

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NO. 3898 P. 5/8

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.
PCT/JP 00/03041

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Claims	4-7, 9, 13-15, 17-26	YES
	Claims		NO
Inventive step (IS)	Claims	4-7, 9, 13-15, 17-26	YES
	Claims		NO
Industrial applicability (IA)	Claims	4-7, 9, 13-15, 17-26	YES
	Claims		NO

2. Citations and explanations

Document 1: JP, 5-229871, A (Toshiba Corp.), 7 September 1993

Document 2: JP, 3-5375, A (Toshiba Corp.), 11 January 1991

Claims 4-7, 9, 13-15, and 17-22

The inventions described in Claims 4-7, 9, 13-15, and 17-22 involve an inventive step relative to Documents 1 and 2.

Documents 1 and 2 do not disclose the inclusion of crystalline carbon and at least either amorphous carbon or carbon in solid solution in an aluminum nitride crystal phase in a matrix comprising aluminum nitride. Moreover, a person skilled in the art would not easily conceive of this feature.

Claims 23 to 26

The inventions described in Claims 23 to 26 involve an inventive step relative to Documents 1 and 2.

Documents 1 and 2 do not disclose the inclusion of at least either amorphous carbon or carbon in solid solution in an aluminum nitride crystal phase in a matrix comprising aluminum nitride, nor do they indicate that the lightness as stipulated in JIS Z 8721 is N4 or less.

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NO. 3898 P. 6/8

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No.

PCT/JP 00/03041

Moreover, a person skilled in the art would not easily
conceive of these features.